

REMARKS/ARGUMENTS

The above-identified patent application has been reviewed in light of the Examiner's final Action dated June 12, 2008. No claims have been amended or canceled by this paper. Accordingly, Claims 1-15 and 18 are now pending. As set forth herein, reconsideration and withdrawal of the rejections of the claims are respectfully requested.

Initially, the Applicant would like to thank the Examiner for the courtesies extended during the telephone interview that was held on July 28, 2008, between Examiner Gray and the undersigned. During that telephone conference, the undersigned suggested an amendment to Claim 1 to remove a phrase that is the subject of the pending indefiniteness rejections. In addition, the undersigned argued that removal of this phrase should not require a new search, as the basis on which the claims were found to be allowable over the prior art does not require its inclusion. However, the Examiner indicated that removal of the phrase would change the scope of the claim, thereby necessitating an additional search and the submission of a Request for Continued Examination. In view of the Examiner's position, the undersigned is submitting this Response After Final, which the Examiner agreed to consider in reconsidering the status of the pending indefiniteness rejections. Apart from the status of Claim 18 as allowed, no agreement regarding allowable subject matter was reached.

Claims 1-15 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In particular, the Examiner finds that the phrase "wherein in the third mode and while the plunger and barrel retract the position of the outer housing relative to the energy source is fixed" in the last element of the claim can be interpreted multiple ways. Specifically, the Examiner states that this phrase can be interpreted one of two ways: 1) the plunger and barrel retract the outer housing; or 2) the plunger/barrel retract, and the outer housing and energy source are fixed (raising a further question as to whether the outer housing, the energy source, or both are fixed). The Applicant notes that the multiple interpretations of this phrase by the Examiner misstate the clear language of the claim and seek to add an ambiguity that is not in fact present in the text of the claim. In particular, considered in its entirety, there is no ambiguity in Claim 1.

In order to comply with the requirement for definiteness under 35 U.S.C. §112, second paragraph, the claims must set out and circumscribe a particular subject matter with a

reasonable degree of clarity and particularity. (MPEP §2173.02.) In reviewing a claim for compliance with 35 U.S.C. §112, second paragraph, “the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope, and therefore serves the notice function . . . by providing clear warning to others as to what constitutes infringement of the patent.” (Id., citing *Solomon v. Kimberly-Clark Corp.* 216 F.3d 1372, 1379, 55 USPQ 2d 1279, 1283 (Fed. Cir. 2000)).” If the language used by the Applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the Examiner merely wants the Applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the Examiner should suggest improved language to the Applicant.” (Id).

The last element of Claim 1 recites a third mode in which the plunger and barrel retract relative to the inner housing and the outer housing. The phrase objected to by the Examiner further specifies that “while the plunger and barrel retract [a further condition is present]”. This further condition is that “the position of the outer housing relative to the energy source is fixed.” No portion of Claim 1 is indefinite when the claim is considered as a whole.

The Examiner’s First Proposed Interpretation is Clearly Incorrect

To interpret the phrase as meaning that the outer housing is retracted by the plunger and barrel applies an improper grammatical construction to the claim. Specifically, to interpret the plunger and barrel as retracting the position of another component is improper. In particular, “the position” of a thing cannot be retracted. Instead, a thing is itself retracted, which can have the result of altering the position of the thing.

Another reason that the first of the Examiner’s proposed interpretations is improper is that, in the context of the entire claim, it is clear that the retraction of the plunger and barrel refers to their movement relative to other components. Indeed, in the phrase immediately preceding the phrase subject to the indefiniteness rejection, it is stated that “the plunger and barrel retract relative to the inner housing and the outer housing.” Thus, it is clear that the phrase “while the plunger and barrel retract” describes the state of the plunger and the barrel, not an action taken by the plunger and the barrel.

Still another the reason the Examiner's first proposed interpretation is incorrect is that it is nonsensical.

The Examiner's Second Proposed Interpretation is Clearly Correct, and That Interpretation Does Not Introduce Any Subsidiary Ambiguity

The objected to phrase clearly means that, while the plunger and the barrel retract, the position of the outer housing relative to the energy source is fixed. However, the questions raised in the Office Action as to which element is fixed if the objected to phrase means that the plunger and barrel retract ignore the plain meaning of the phrase. In particular, it is quite clear that it is the position of the outer housing relative to the energy source that is fixed. Any other interpretation would necessarily apply an incorrect grammatical construction to the claim.

If the Examiner believes that some correction to the claim is necessary in order to remove a perceived indefiniteness problem, Applicant requests that the Examiner suggest amended language that in the Examiner's view would improve the clarity or precision of the language used. (See MPEP §2173.02.) Applicant notes that any such amendment should not require the filing of an Request for Continued Examination in order to obtain an additional search. In particular, the Examiner, having already applied different interpretations to the claim, has nonetheless withdrawn any rejections based on the prior art of record.

In summary, the phrase subject to the indefiniteness rejection is sufficiently clear and definite when proper grammatical rules are applied. Therefore, the claim is not indefinite, and the rejections under 35 U.S.C. §112, second paragraph, should be reconsidered and withdrawn, and Claims 1-15 should be allowed. Alternatively, the rejection should be reconsidered and withdrawn pending the entry of an amendment to address the Examiner's concerns, and Claims 1-15 should be allowed without requiring an additional search.

The application now appearing to be in form for allowance, early notification of same is respectfully requested. The Examiner is invited to contact the undersigned by telephone if doing so would expedite the resolution of this case.

Respectfully submitted,

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